

REMARKS/ARGUMENTS

Applicants believe the corrected Listing of Claims submitted herein meets the requirements of 37 CFR 1.121.

In view of the above amendments and the following remarks, favorable reconsideration of the outstanding office action is respectfully requested.

Upon entry, claims 1-19 remain in this application. Claim 17 has been amended. Claims 20-31 have been canceled, without prejudice.

Restriction Requirement

The Examiner issued a Restriction Requirement identifying the following groups of claims as being drawn to potentially distinct inventions:

Group I. Claims 1-19 and 26-31, drawn to a method of forming soot for glass, classified in class 65, subclass 377;

Group II. Claims 20-25, drawn to an apparatus for forming soot, classified in class 65, subclass 484.

The Examiner asserted that these inventions may be regarded as independent and distinct from one another because the apparatus as claimed can be used to practice another process, such as one where there is no transition between liquids.

In a telephone conference with the undersigned agent of record dated May 28, 2003, a provisional election to Group I was made, with traverse. Applicants hereby confirm that provisional election, with traverse.

Applicants respectfully traverse the Examiner's Restriction Requirement on the grounds that the proposed inventions are inextricably intertwined, and prosecution of the proposed groups of claims together would be most effective for the Office. In order to conduct a comprehensive search regarding any one of the groups, including the group provisionally elected above, it would be inherently necessary to review the same pertinent fields and classes of prior art relating to the

other groups. Moreover, the important questions of patentability and claim interpretation are likely to be based on substantially similar issues and evaluations for each group of claims, and would require consideration of the same prior art, and combined prosecution is therefore less likely to result in inconsistent or conflicting file histories.

As such, Applicants respectfully request that the Examiner withdraw the Restriction Requirement in the next subsequent Office Action, and continue prosecution of Groups I-II.

Contingent upon the Examiner's decision not to withdraw the Restriction Requirement, Applicants have canceled claims 20-25, without prejudice.

Specification

The Examiner has objected to the specification as lacking an Abstract. The abstract as originally filed is presented on a separate paper with the present Response.

Applicants have also amended the specification to include a priority claim to PCT application serial number PCT/US99/16176, which in turn claims priority to U.S. provisional application number 60/095,735.

Claim Objections

The Examiner has objected to claims 17-19 under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, that claim 17 is directed to step d) in claim 1 when claim 1 has no step d). Applicants believe the enclosed amendments satisfy the requirements of 37 CFR 1.75(c). Specifically, claim 17 has been amended to depend from claim 2, which includes step d).

Allowed Claims/Subject Matter

Applicants note with appreciation the Examiner's allowance of claims 1-16.

§ 112 Rejections

The Examiner has rejected claims 26-31 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out or distinctly claim the subject matter which

applicants regard as the invention. In particular, the Examiner asserts that claim 26, line 23 refers to "a group of liquids consisting of a liquid reactant or a second liquid" and that this language is not understandable.

Applicants believe the enclosed amendments satisfy the requirements of 35 U.S.C. §112, second paragraph. Specifically, Applicants have canceled claims 26-31.

The Examiner has rejected claim 27 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Applicants believe the enclosed amendments satisfy the requirements of 35 U.S.C. §112, first paragraph, specifically that the cancellation of claims 26-31 makes the rejection moot.

§ 103 Rejections

The Examiner has rejected claims 26-31 under 35 U.S.C. §103 as being unpatentable for obviousness over U.S. Patent No. 4,230,744 (Blankenship).

Applicants believe the enclosed amendments satisfy the requirements of 35 U.S.C. §103. Specifically, cancellation of claims 26-31 make the rejection moot.

Conclusion

Based upon the above amendments, remarks, and papers of records, applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.


Applicant believes that no extension of time is necessary to make this Reply timely. Should applicant be in error, applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Appl. No.: 09/762,274
Reply to Office Action of: 10/3/03

Please direct any questions or comments to Kevin M. Able at 607-974-2637.

Respectfully submitted,

DATE: 10/15/03

A handwritten signature in black ink, appearing to read "Kevin M. Able", is written over a horizontal line.

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